

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance or into better condition for appeal. During the October 22, 2003 telephone interview with the Examiner, for which the Examiner is thanked for the courtesies extended thereat, the Examiner agreed to enter this Amendment.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-25 are pending. Claim 1 was amended, without prejudice.

No new matter is added by this amendment.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments and remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the amendments and remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Support for the amended recitations in the claims is found throughout the specification and from the pending claims.

II. 35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Claim 1 was rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. The rejection is traversed.

The amendment to claim 1, without prejudice, renders the rejection moot.

Consequently, reconsideration and withdrawal of the Section 112, second paragraph, rejection are respectfully requested.

III. 35 U.S.C. § 102 REJECTIONS

Claims 1-15 and 23 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Bryan and one of either Takahashi or Dunn and one of Ibsen '016 or Zalsman or Lee and one of either Jacobs or Oxman or Ibsen '489. The rejection is traversed.

The instant invention is directed to, for example, a kit for bonding silicone compositions to a base surface made from polymers, polymers of methacrylates or fillers with said surface being part of a structure which includes an impression tray, dental crown, bridge, temporary crown or temporary bridge, comprising a) at least one partially re-soluble (co-)polymer adapted to form a first layer on said base surface; and b) at least one adhesive for silicone adapted to form a second layer in an overlying relationship to said first layer.

None of the nine (9) disparate documents relied upon by the Examiner disclose, teach, suggest or imply such a relationship. Indeed, none of these documents disclose, teach, suggest or imply such a relationship in a kit for bonding silicone compositions to a base surface made from polymers, polymers of methacrylates or fillers with said surface being part of a structure which includes an impression tray, dental crown, bridge, temporary crown or temporary bridge comprising a two-layer structure.

As the documents cited by the Examiner do not contain each and every element of the claimed invention, the anticipation rejection must fail as a matter of law.

Consequently, reconsideration and withdrawal of the Section 102(e) rejection are respectfully requested.

IV. 35 U.S.C. § 103 REJECTIONS

Claims 1-15 and 23 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Brian and either Takahashi or Dunn and either Jacobs or Oxman or Ibsen '489 and either Ibsen

'016 or Zalsman or Lee. The rejection is respectfully traversed. None of the references, either individually or in combination, teach or suggest Applicants' invention.

It is respectfully asserted that it is well-settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

None of the nine (9) disparate documents satisfy the requirements for obviousness. In other words, none of the nine documents possess the requisite suggestion or disclosure that would lead a skilled artisan to practice, *inter alia*, the instantly claimed kit for bonding silicone compositions to a base surface made from polymers, polymers of methacrylates or fillers with said surface being part of a structure which includes an impression tray, dental crown, bridge, temporary crown or temporary bridge, comprising a two layer structure.

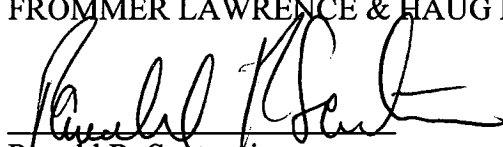
Consequently, reconsideration and withdrawal of the Section 103 rejections are warranted and respectfully requested.

CONCLUSION

By this Amendment, the instant claims should be allowed; and this application is in condition for allowance or in better condition for appeal. Favorable reconsideration of the application, withdrawal of the rejections and objections, and prompt issuance of the Notice of Allowance are, therefore, all earnestly solicited.

Respectfully submitted,
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